

REMARKS

In response to the Office Action dated July 15, 2004, the Applicant has amended independent claims 1, 6, 9, 14 and 17. Claims 1-20 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action objected to the drawings. Namely, Fig. 1 was objected to as not having the term --Prior Art-- as the legend. Also, Fig. 3 was objected to as having a reference number ("325") designated to two different elements and having element 325 missing a connecting arrow between itself and element 360.

In response, the Applicant has amended Fig. 1 to include a legend with the term --Prior Art --. Also, Fig. 3 has been amended to replace reference number 325 for the step "Place Micro Advertisement" with reference number --355--. In addition, a connecting arrow has been added from the step of "Place Micro Advertisement" (reference number previously was labeled as 325 and has been amended to 355) to the step "Is There Space Remaining" (reference number 360). No new matter was added for these amendments.

The Office Action objected to the disclosure due to minor informalities and typographical errors.

In response, the Applicant has amended the specification as suggested to overcome this objection.

The Office Action rejected claims 1-20 under 35 U.S.C. 112, first paragraph, as allegedly based on a disclosure that is not enabling. In particular, the Examiner stated that "...there is a lack of enablement regarding 'determining available space on the page for the micro-advertisement, the available space not interfering with the information content.'"

The Applicants respectfully traverse this rejection and submit that the disclosure is enabling. Namely, paragraphs [0015] through [0020] with reference to Figs. 2-3 of the Applicant's disclosure is enabling with respect to the claims because it describes a typical web page with information content and determining unused available space on that page for placing the micro-advertisements in the unused available space. Although the specification does not disclose specific scripts or the exact programming code to "determining available space on the page for the micro-advertisement, the available space not interfering with the information content", this amount of detail is not required. The Examiner is reminded that patent applications are written for persons familiar with the relevant field; the patentee is not required to

include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

It is well settled that when rejecting a claim under the enablement requirement of § 112, the Examiner bears an initial burden of setting forth a reasonable explanation as to why he believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. The Examiner must give a detailed explanation, which he has not and cannot, supported by the record as a whole, why the specification is not enabling, including a showing that the disclosure entails undue experimentation. In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976).

Examiners can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999). Last, the court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. As such, for these reasons, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. 112, first paragraph.

Claims 1-4 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cottingham (U.S. Patent No. 6,339,761). Claims 6-11, 14, 15 and 17-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Gupta et al. (U.S. Patent No. 6,487,538). In addition, claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable by Cottingham in view Gupta et al. Also, claims 12, 13, 16 and 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable by Gupta et al. in view of Davis et al.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's invention includes determining available unused space on the web page for the micro-advertisement, the available space not interfering with the information content, selecting the micro-advertisement, from a plurality of micro-advertisements, to place on the web page and placing the micro-advertisement on the web page in the available unused space.

With regard to the rejections under U.S.C. 102, the Applicant respectfully submits that Cottingham does not disclose, teach, or suggest all of the claimed features of claims 1-4. For example, although the Examiner argued that Cottingham discloses providing an ISP with control over who receives an advertisement, clearly, this is very different from the Applicant's claimed determining available unused space on the web page for the micro-advertisement. Instead, Cottingham discloses replacing an existing advertisement from a web page creator with an advertisement from an ISP (see col. 5, lines 32-47 and FIG. 3 of Cottingham). Contrary to the Examiner's argument, Cottingham fails to disclose the Applicant's claimed determining available unused space on the web page.

The *MPEP*, explicitly states that "[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." [*emphasis added*] *MPEP* 2131, citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, the Examiner has failed to show all of the claimed elements in the Cottingham reference. This is because the cited references do not disclose the above argued features. As such, the Applicant submits that the rejection should be withdrawn.

With regard to the rejection under U.S.C. 103(a) of the rest of the claims, the Applicants submit that the Cottingham reference, alone or in combination with the Gupta et al. or Davis et al. reference do not disclose, teach, or suggest all of the claimed features of the amended claims. As discussed above, none of the cited references, in combination or alone, disclose the Applicant's determining available unused space on the web page for the micro-advertisement. Although the Examiner argued that Gupta et al. disclose an "empty slot", this "empty slot" is preconfigured to be the location for an advertisement (see col. 11, lines 14-24). In contrast, the Applicant's claimed invention determines available unused space on the web page for the micro-advertisement, the available space not interfering with the information

content and then selects the micro-advertisement to be placed on the web page in the determined available unused space.

As such, clearly, the cited references, when **combined**, are missing at least one limitation of the Applicants' claimed invention. To make a prima facie showing of obviousness, all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Further, the Examiner took the references out of context and used improper hindsight when he summarily concluded that the references disclose the Applicant's claimed determining available unused space on the web page for the micro-advertisement. This is because nowhere in the references is there a disclosure of this feature. The Examiner is reminded that the "...combination of elements...in a manner that reconstructs the applicant's invention only with the benefit of hindsight...is insufficient to present a prima facie case of obviousness." There must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Further, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...**the opportunity to judge by hindsight is particularly tempting.** Consequently, the tests of whether to combine references need to be applied rigorously." McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Therefore, since the Examiner has failed to provide references with all of the Applicant's claimed limitations, the rejection is improper and a prima facie case of obviousness cannot be established. In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP* 2143.

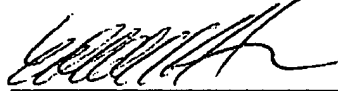
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With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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Attachments